



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,713	04/19/2007	Yoshihito Ohkawa	1000023-000114	3547
21839 7590 05/27/2009 BUCHANAN, INGERSOLL & ROONEY PC POST OFFICE BOX 1404 ALEXANDRIA, VA 22313-1404				
EXAMINER				
LEE, DORIS L				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
05/27/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

Attachment to Advisory Action

1. Applicants' amendment filed May 12, 2009 has been fully considered; however, the amendment has not been entered given that it introduces the issue of new matter and raises other new issues that would require further consideration and/or search.

With respect to the issue of new matter, claim 1 recites a new limitation which reads "and when the other salt of zinc is zinc stannate or calcium zinc molybdate, the mass ratio of zinc borate and zinc stannate or calcium zinc molybdate is 1:1". It is the examiner's position that this phrase fails to satisfy the written description requirement of 35 USC 112, first paragraph since there does not appear to be a written description requirement of the new limitation in the application as originally filed, *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989) and MPEP 2163. While there is the recitation of the amount of the two flame retardants in Table 1 of the specification, the newly amended limitation stated above does not have support, because the examples presented in Table 1 are not commensurate with the scope of the claims. For example, the claim reads "10 to 80% by mass of a polyamide" and the embodiments provide data for compositions of only 42% polyamide. The same argument can be applied to the other components in the composition.

With respect to new issues, independent claim 1 has been amended to include new limitations which combine elements of previous claims 2 and 3, also claim 15 is new and has not previously been considered. It is the examiner's position that this is a new issue since this combination was not presented before, i.e., claims dependent on 1

were not presented before with this combination. Therefore, the amendment would require further consideration and/or search.

2. In the interest of better enabling the applicants to assess the patentability of their claims, the following advisory is given:

3. **Applicant's arguments:** The inventive examples and the comparative examples and the declaration filed on 11/17/2008 show unexpected and superior results. It is noted that the Applicant has submitted the Declaration as an additional comparative example which the Applicant states is in accordance with the invention of JP '411.

Examiner's response: *The data submitted by applicant is not commensurate in scope with the scope of the claims, hence the data is not persuasive over the entire scope of the claims. For example, the claim 1 has a limitation of 10 - 80 % by mass of polyamide, however, the data presented has only 41-42 % by weight polyamide. The claim also has limitations of 5-40% by mass of a flame retardant, 0-60 % by mass of a inorganic reinforcing material, and 0-5% by mass of a drip preventing agent while the data provides information only on 21-23 wt % of a poly bominated styrene, 30 wt% of glass fiber and 1-2 wt % of Maleated SEBS. The examiner can not determine if the unexpected results are present in compositions, for example, with no inorganic reinforcing materials and no drip preventing agents or if the unexpected results are present at flame retardant concentrations or flame retardant types that are different than the presented data but fall under the scope of the instant claims. Therefore, the criticality of the claimed range has not been elucidated. It is also noted that unexpected results can not overcome an anticipatory rejection.*

4. **Applicant's arguments:** JP '441 does not teach all the limitations of claim 1, namely the mixture of zinc borate and at least one other salt of zinc which is specifically recited in claim 1 of the present application.

Examiner's response: *The limitations of the claims are met in paragraph [0010] which states that **one or more kinds** of compounds selected from oxides containing zinc and zinc salts of phosphoric acid. Paragraph [0038] lists all the types of zinc compounds which zinc borate is listed as the preferential zinc oxide. Although the application lists only one type of zinc compound in each of the embodiments, the teaching of JP '411 is taken in light of the whole specification and not only the embodiments presented.*

5. **Applicant's arguments:** JP '411 does not recognize that by using a combination of zinc borate at least one other salt of zinc, one can obtain advantageous properties illustrated in the evidence of record.

Examiner's response: *The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See Ex parte Obiaya, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).*

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Doris L. Lee whose telephone number is (571)270-3872. The examiner can normally be reached on Monday - Thursday 7:30 am to 5 pm and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571)272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Doris L Lee/
Examiner, Art Unit 1796

/Vasu Jagannathan/
Supervisory Patent Examiner, Art Unit 1796